

## REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-19 are rejected under 35 U.S.C. 102(b) over the German patent document to Hyodo.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants amended the claims to more clearly define the present invention and to distinguish it from the prior art.

It is respectfully submitted that claims 1 and 15, the broadest claims defining the motion sensor and the method for producing the motion sensor in accordance with the present invention as amended, clearly and patentably distinguish the present invention from the prior art.

The German patent document required by the Examiner discloses a plug contact part for a motor vehicle with a plug contact arranged in the housing and a IC-component. Three plug contacts 2-4 shown in Figures 1 and 2 are configured as conventional metal parts, and not as one (both) plastic components by metallization on the outer surface. In contrast to the present invention as defined in claims 1 and 15 as amended, this reference does not

disclose such a device in which a plastic basic body of a basic component is composed of at least two different plastic components. This reference does not clearly disclose how the plug contacts 2-4 are held inside the housing. The reference does not provide any hint or suggestion whether a basic component disclosed in it is similar to the basic component of the applicant's invention. Also, this reference does not disclose any diamagnetic or paramagnetic cover, but just a conventional housing 1.

When in accordance with the present invention the basic component is composed of two different plastic components, at least one of which is metallized on its surface for forming at least one conductor track, the motion sensor on the one hand can be produced lighter, and on the other hand achieves a higher miniaturization degree. When the motion sensor is designed in accordance with the present invention, it can be produced with the length of only about 2 cm, which is possible for the device disclosed in the reference only with higher expenses.

In the reference a plug contact part can be produced with lower expenses, by arranging the IC component on the plug contacts, in which case on the other hand a relative movement between the plug contact and the IC-component is excluded. In contrast, in accordance with the applicant's invention the IC is not arranged on the plug contact parts, but instead on the metallized

surface of one of the plastic components. It is therefore believed to be clear that the German reference discloses a solution which is going in a totally opposite direction, in particular towards the simplification of the device by maintaining of the available plug contacts for contacting with the IC.

The original claims were rejected over this reference as being anticipated. In connection with this, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the German reference does not disclose each and every element of the present invention as now defined in the independent claims.

As explained herein above, the present invention also provides for the highly advantageous results which can not be accomplished by the solution proposed in the reference. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

The present also can not be derived from references as a matter of obviousness. A person of ordinary skill in the art would not arrive at the applicant's invention from the teaching of the reference for the reasons explained herein above, but instead he has to fundamentally modify the solution proposed in the reference by including into it the features which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.


In view of the above presented remarks and amendments, it is believed that claims 1 and 15 as amended should be considered as clearly and patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the dependent claims, they share their allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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